

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: S. K. Davidsen, et al.

Serial No.: Continuation of prior application No.
09/239,087, Examiner: R. Gerstl, Group /Art Unit
1626

File No. of prior application: 6162.US.P1

Filed: January 27, 1999

For: REVERSE HYDROXAMATE INHIBITORS
OF MATRIX METALLOPROTEINASES

Case No.: 6162.US.C1

Date: July 11, 2001

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PRELIMINARY AMENDMENT

Director of Patents and Trademarks
Washington, D.C. 20231

Dear Sir:

Applicants request entry of the following amendment and reconsideration of the
subject application in view of the following remarks. Applicants have also submitted
herewith a Petition for Revival of an Application For Patent Abandoned Unintentionally.

IN THE SPECIFICATION

Directly beneath the title, please insert the following sentence:

This application is a continuation of U.S. Application Ser. No. 09/239,087, filed
January 27, 1999.

IN THE CLAIMS

Please replace Claims 14 and 21 with the correspondingly numbered claims.

14 (Amended). A compound according to claim 23 selected from the group consisting of

N-[4-[4-[[4-(4-chlorophenoxy)phenyl]sulfonyl]methyl]tetrahydro-2H-pyran-4-yl]-*N*-hydroxyformamide and

N-[4-[4-[(4'-chloro[1,1'-biphenyl]-4-yl)sulfonyl]methyl]tetrahydro-2H-pyran-4-yl]-*N*-hydroxyformamide.

21 (Amended). A compound according to claim 23 which is [S-(R*,R*)]-*N*-[1-(2,2-dimethyl-1,3-dioxol-4-yl)-2-[[4-[4-(trifluoromethoxy)phenoxy]phenyl]sulfonyl]ethyl]-*N*-hydroxyformamide.

Please add the following new claims:

23 (New). A compound according to Claim 7 wherein X is -S(O)_p-; and R₂ is hydroxyalkyl or heterocycle.

24 (New). A compound according to Claim 23 wherein Y is a covalent bond, -O-, or -S(O)_p-; and Ar₂ is phenyl wherein the phenyl can be optionally substituted.

25 (New). A compound according to Claim 24 which is [S-(R*,R*)]-*N*-hydroxy-*N*-[(2,3-dihydroxy)-1-[[4-[4-(trifluoromethoxy)phenoxy]phenyl]sulfonyl]methyl]propyl]-*N*-hydroxyformamide.

26 (New). A compound according to Claim 13 wherein X is -S(O)_p-; Y is a covalent bond, -O-, or -S(O)_p-; and Ar¹ and Ar² are phenyl wherein the phenyl can be optionally substituted.

REMARKS

Claims 1-17, 19-22 were pending. After entry of the above amendment, Claims 1-17 and 19-26 will be pending.

The amendment accompanying these remarks amends Claims 14 and 21 and adds New Claims 23-26.

Support for New Claims 23, 24, and 26 can be found in the claims as originally presented and from page 2, line 1 to page 10 line 21 of the specification.

Support for New Claim 25 is found on page 24, lines 13-15 and on pages 127 and 128, lines 12-30 and 1-9, respectively, of the specification.

Double Patenting Rejections

Claims 1-13, 15-17, and 19-22 stand provisionally rejected as being unpatentable over Claims 1-13, 15, 17, and 18 of copending Application No. 09/492,567 and over Claims 1-13, 15, 17, and 18 of copending Application No. 09/492,718.

Applicants will file a Terminal Disclaimer, pursuant to 37 CFR §§ 1.321, for copending Application Nos. 09/492,567 and 09/492,718.

Claim 14 stands provisionally rejected as being unpatentable over Claim 14 of copending Application No. 09/492,567. The Examiner required cancellation of the conflicting claims from all but one application or maintenance of a clear line of demarcation between the applications.

Claims 14 and 18 stand provisionally rejected as being unpatentable over Claim 14 and 16 of copending Application No. 09/492,718. The Examiner required cancellation of the conflicting claims from all but one application or maintenance of a clear line of demarcation between the applications.

Applicants will amend the claims in copending Application Nos. 09/492,567 and 09/492,718 to maintain of a clear line of demarcation between the claims therein and the instant claims.

Because Application No. 09/492,567 will have a clear line of demarcation between the claims therein and the instant claims and Application Nos. 09/492,567 and 09/492,718 will have the same pendency as the instant application, the double patenting rejection has been rendered moot, and withdrawal of the rejection is respectfully requested. Applicants would be pleased to supply confirmation of the Terminal Disclaimer and cancellation of the claims in the copending applications upon the Examiner's request.


Conclusion

Accordingly, in view of the above, Applicants respectfully request reconsideration and allowance of claims 1-17 and 19-26.

The Director is hereby authorized to charge any additional fees required under 37 C.F.R. §§ 1.16 concerning this transaction or to credit any overpayment to Deposit Account No. 01-0025.

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